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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,712	08/07/2003	Hiraku Murayama	1011350-000318	1927

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BUCHANAN, INGERSOLL & ROONEY PC  
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EXAMINER
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FOREMAN, JONATHAN M

ART UNIT	PAPER NUMBER
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3736

NOTIFICATION DATE	DELIVERY MODE
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10/31/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/635,712	<b>Applicant(s)</b> MURAYAMA ET AL.	
	<b>Examiner</b> JONATHAN ML FOREMAN	<b>Art Unit</b> 3736	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 July 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,5-8,10-15,17 and 19-24 is/are pending in the application.
- 4a) Of the above claim(s) 21-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,7,8,10,11,14,15 and 17 is/are rejected.
- 7) ☒ Claim(s) 5,6,12 and 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/10/08</u> .   | 6) <input type="checkbox"/> Other: _____                          |

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### **DETAILED ACTION**

1. The following Office Action contains rejections to previously allowed and/or previously objected-to-as-allowable material as indicated in Office Action mailed 4/10/08. Accordingly, the following action has been made Non-Final.

#### ***Information Disclosure Statement***

2. The information disclosure statement filed 7/10/08 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

#### ***Election/Restrictions***

3. It is noted that claims 21 – 24 were nonelected in the reply filed on 12/15/06 and cancelled in the Examiner's Amendment mailed 7/12/07.

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3, 7, 8, 10, 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,865,768 to Orr in view of JP 11-0000737 to Toshiba Corp.

In regard to claims 1, 3, 7, 8, 10, 11 and 14, Orr discloses a guide wire (Figure 1) including a first wire (30) disposed on the distal side of the guide wire; a second wire (25) disposed on the proximal side from the first wire, the second wire having rigidity higher than that of the first wire (Col. 2, lines 44 – 64); wherein the first wire and the second wire are joined to each other by welding

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(Col. 2, line 54); a cover layer is disposed over the welded portion (Col. 3, lines 8 – 9); the first wire and the second wire are not helical coils; material forming at least one of the proximal end of the first wire and the distal end of the second wire constitutes at least a part of the weld; the second wire has a first portion provided in the vicinity of the distal end of the second wire and a second portion provided on the proximal side from the first portion; and the first portion has rigidity lower than that of the second portion as a result of a taper (Figure 1). Orr discloses a spiral coil (15) covering at least a distal end portion of the first wire. The Examiner considers the location of the weld to be on a thinned portion of the guide wire. Although Orr discloses a welded portion, Orr fails to disclose the welded portion formed by the welding having a projection projecting in the outer peripheral direction; the projection extending on both axial sides of the welded portion. However, Toshiba Corp. teach a welded portion between two wires having a projection projecting in the outer peripheral direction; the projection extending on both axial sides of the welded portion. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the welded portion disclosed by Orr to include a projection as disclosed by Toshiba Corp. to improve the strength of the weld [0041].

6. Claims 15, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,980,471 to Jafari in view of JP 11-0000737 to Toshiba Corp.

In regard to claims 15, 17, 19 and 20, Jafari discloses a guide wire (Figure 1) having a first wire (12) being formed of a pseudo-elastic alloy (Col. 6, lines 62 – 65) and disposed on the distal side of the guide wire; a second wire (11) being formed of a Co-based alloy and disposed on the proximal side from the first wire (Col. 8, lines 38 – 46); a spiral coil (22) covering at least a distal end portion of the first wire; wherein the first wire and the second wire are joined to each other at a portion (Figure 3) and a cover layer (Col. 6, lines 36 – 42) is disposed over the portion. The first wire

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comprises a reduced outer dimension portion possessing an outer dimension smaller than the outer dimension of the joined portion and smaller than the outer dimension of a distally located portion of the first wire, the reduced outer dimension portion of the first wire being positioned between the joined portion and the distally located portion of the first wire (Figure 3); the second wire comprises a reduced outer dimension portion possessing an outer dimension smaller than the outer dimension of the joined portion and smaller than the outer dimension of a proximally located portion of the second wire, the reduced outer dimension portion of the second wire being positioned between the joined portion and the proximally located portion of the second wire (Figure 3). However, Jafari fails to disclose the joined portion including a welded portion forming a projection that projects in an outer peripheral direction; the material forming at least one of the proximal end of the first wire and the distal end of the second wire constituting at least a part of the projection. However, Toshiba Corp. teach joining two wires with a welded portion having a projection projecting in the outer peripheral direction; the projection extending on both axial sides of the welded portion. The claims would have been obvious because the substitution of one known element for another would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Because both Jafari and Toshiba Corp. teach mechanisms for joining two wires together it would have been obvious to one skilled in the art at the time of the invention to substitute one mode of connection for the other to achieve the predictable results of firmly joining together the two wires.

***Allowable Subject Matter***

7. Claims 5, 6, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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***Response to Arguments***

8. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736